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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/057,503	01/25/2002	David C. Issler	10294-607001	4327

7590

11/18/2003

ST. ONGE STEWARD JOHNSON & REENS LLC  
986 BEDFORD STREET  
STAMFORD, CT 06905-5619

EXAMINER
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STASHICK, ANTHONY D

ART UNIT	PAPER NUMBER
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3728

DATE MAILED: 11/18/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/057,503

Applicant(s)

ISSLER

Examiner

Anthony D Stashick

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-- Th MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-25 and 27-29 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-25 and 27-29 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☒ The proposed drawing correction filed on 05 September 2003 is: a) ☒ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

***Drawings***

1. The proposed drawing correction and/or the proposed substitute sheets of drawings, filed on September 5, 2003 have been accepted. A proper drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The correction to the drawings will not be held in abeyance.

***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1-4, 7, 18-20, 23 and 26-27 are rejected under 35 U.S.C. 102(b) as being anticipated by Haag 1,724,349. Haag '349 discloses all the limitations of the claims including the following: an outsole 1 and 3 having an inner surface (top surface of 1) including an opening (that located above opening 6 in heel lifts); a footbed 7 positioned over the inner surface of the outsole; the footbed 7 having a lower surface including a

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plug 9 configured to be inserted into the opening (see Figures 1 and 4); the footbed formed of a material having a first hardness characteristic (made of rubber) that is less than an outsole material (for instance TPU or even wood) having a second hardness characteristic; the plug 9 is formed of a material having a first hardness characteristic that is less than an outsole material (for instance TPU or even wood) having a second characteristic; the footbed and the plug are formed of a material (both made of rubber) having substantially the same hardness; the opening is positioned in a heel area of the inner surface of the outsole (see Figures 1 and 4); an upper 2; an insole 7. With respect to claims 18-20 and 23, the limitations of these method steps are met by the presence of the limitations in the product shown.

4. Claims 1, 7, 18, 23, 26 and 27-28 are rejected under 35 U.S.C. 102(b) as being anticipated by Schaff 1,717,122. Schaff '122 discloses all the limitations of the claims including the following: an outsole B (including top layer of the heel as seen in Figure 1), having an inner surface (that facing the inner portion of the shoe upper) including an opening (that located near D) and having a heel area (see heel in Figure 1) and a toe area (see Figure 1); a footbed H positioned over the inner surface of the outsole and extending from the heel to the toe

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(see Figure 4, heel is shown with plug, then the arch area is clearly shown by I, and then that portion forward of I is the toe end); the footbed having a lower surface including a plug E configured to be inserted into the opening (see Figure 1); the opening is positioned in a heel region of the inner surface (see Figure 1); an upper (see Figure 1); an insole H. With respect to claims 18 and 23, the limitations of these method steps are met by the presence of the limitations in the product shown.

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

6. Claims 5, 6, 21 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Haag 1,724,349 in view of Design Choice. Haag '349 discloses all the limitations substantially as claimed except for the specific hardnesses of the material used for the outsole, footbed and plug. It appears that it would have been a mere matter of design choice to choose the

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hardness of the material to be used for the footbed, plug and outsole to meet the desired function of cushioning the user's foot upon impact and durability of the sole. Therefore, it would have been obvious, to one of ordinary skill in the art at the time the invention was made, to make the footbed, plug and outsole out of a material made of any desired hardness to aid in cushioning the user's foot and prevent wear, as desired.

7. Claims 2-6, 19-22 and 27 are rejected under 35

U.S.C. 103(a) as being unpatentable over Schaff 1,717,122.

Schaff '122 discloses all the limitations substantially as claimed. Schaff '122 does not specifically teach the material used for the footbed, plug and outsole. However, Schaff '122 does teach that the footbed and plug are cushions and that the sole is made to survive normal wear and tear. Therefore, it would have been obvious, to one of ordinary skill in the art at the time the invention was made, to make the cushion and plug out of a material that is less hard than the sole, to provide cushioning, while making the outsole out of harder material to survive normal wear and tear of the sole contacting the ground. With respect to the Shore hardness limitation, it appears that it would have been a mere matter of design choice to determine the hardness of the material to perform the desired function.

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8. Claims 8-17 and 24-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over any one of the references as applied to claims 1 and 8 above in view of Lober 844,882. The references as applied to claims 1 and 8 above disclose all the limitations of the claims except for the plug having a cap section and a pedestal with a lip being formed by the cap. Lober '882 teaches that a plug depending from the bottom surface of a footbed and fitted within the opening of a sole can have a pedestal b and cap b' with the cap forming a lip extending past the perimeter of the pedestal. The lip of the cap preventing accidental removal of the plug from the opening of the sole. Therefore, it would have been obvious to make the plug of the references as applied to claims 1 and 8 above, with a pedestal and cap, as taught by Lober '882, to aid in holding the plug in the opening and prevent accidental removal of the plug from the opening. With respect to the perimeters of the cap and pedestal, Lober '882 meets these limitations in as much as that which is shown and disclosed by the applicant.

9. Claim 29 is rejected under 35 U.S.C. 103(a) as being unpatentable over Schaff 1,717,122 as applied to claim 28 above in view of Lober 844,882. Schaff '122 discloses all the limitations of the claim except for the plug having first and second protrusions with different peripheries with the second

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protrusion being attached to the first protrusion and having a periphery larger than the periphery of the first protrusion. Lober '882 teaches that a plug can depend from the bottom surface of a footbed and be fitted within the opening of a sole; the plug can have a pedestal (first protrusion b) and cap (second protrusion b') with the cap forming a lip extending past the perimeter of the pedestal. The lip of the cap prevents accidental removal of the plug from the opening of the sole. Therefore, it would have been obvious to make the plug of Schaff '122 as applied to claim 28 above, with a pedestal and cap, as taught by Lober '882, to aid in holding the plug in the opening and prevent accidental removal of the plug from the opening.

#### ***Response to Arguments***

10. Applicant's arguments filed September 5, 2003 have been fully considered but they are not persuasive. Applicant argues that independent claims 1 and 18 require that the outsole have an opening that extends through the outsole and that none of the references applied have the required through hole. This argument is not clearly understood. As noted in the rejections above, each of the references applied to claims 1 and 18 have the required through hole in the sole and therefore meet this limitation in claims 1 and 18. As noted by applicant, both Haag



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and Schaff have holes in the heel, but when looked at in more detail, they each clearly show that the top layer in the heel area is part of the outsole that continues to the front of the foot (see Figure 1 of Schaff and Haag). With respect to applicant's arguments directed to the "depressing action" of Haag, this applies to the heel portion (heel lifts) applied to the heel area onto the outsole. Applicant further argues that both Haag and Schaff show a footbed that extends over only a portion of the outsole. This argument is clearly not understood as figure 4 of Schaff shows a heel area with a plug, an arch area labeled I, and the toe area is that shown forward of the arch area. It is clear that this portion extends to the toes as well as the distance from the heel to the arch and the distance from the arch to the front portion. Although Schaff does describe the invention as providing an improvement in cushion heels combined with an arch support for the arch of the foot, this does not limit the support to only the arch area but the support can be even further forward as shown in Figure 4 with the forward portion not a concern for the inventor of Schaff. Therefore, because all the limitations of the claims are met by the references as applied above, the claims stand rejected as noted above.

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**Conclusion**

2. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Telephone inquiries regarding the status of applications or other general questions, by persons entitled to the information, "should be directed to the group clerical personnel and not to the examiners. In as much as the official records and applications are located in the clerical section of the examining groups, the clerical personnel can readily provide status information without contacting the examiners", M.P.E.P. 203.08. The Group clerical receptionist number is (703) 308-1148.

If in receiving this Office Action it is apparent to applicant that certain documents are missing, e.g., copies of references cited, form PTO-1449, form PTO-892, etc., requests for copies of such

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papers or other general questions should be directed to Tech Center 3700 Customer Service at (703) 306-5648, email [CustomerService3700@uspto.gov](mailto:CustomerService3700@uspto.gov).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anthony D Stashick whose telephone number is 703-308-3876. The examiner can normally be reached on Monday through Thursday 8:00 am-4:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mickey Yu can be reached on 703-308-2672. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-1148.

Other helpful telephone numbers are listed for applicant's benefit.

Allowed Files & Publication	(703) 305-8322
Assignment Branch	(703) 308-9287
Certificates of Correction	(703) 305-8309
Drawing Corrections/Draftsman	(703) 305-8404/8335
Fee Increase Questions	(703) 305-5125
Intellectual Property Questions	(703) 305-8217
Petitions/Special Programs	(703) 305-9282
Terminal Disclaimers	(703) 305-8408
Informal Fax for 3728	(703) 308-7769

If the information desired is not provided above, or has been changed, please do not call the examiner (this is the latest information provided to him) but the general information help line below.

Information Help line	1-800-786-9199
Internet PTO-Home Page	<a href="http://www.uspto.gov/">http://www.uspto.gov/</a>

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A handwritten signature in black ink, appearing to read "Anthony D Stashick". The signature is written in a cursive, flowing style.

Anthony D Stashick  
Primary Examiner  
Art Unit 3728

ADS

November 12, 2003